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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/829,582	04/21/2004	Marek K. Pakulski	020569-07400 (P504-1370-U)	6722
54487	7590	03/30/2006	EXAMINER	
JONES & SMITH, LLP THE RIVIANA BUILDING 2777 ALLEN PARKWAY, SUITE 800 HOUSTON, TX 77019-2141			JOHNSON, EDWARD M	
			ART UNIT	PAPER NUMBER
			1754	

DATE MAILED: 03/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/829,582

Applicant(s)

PAKULSKI ET AL.

Examiner

Edward M. Johnson

Art Unit

1754

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 14 March 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☒ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: 2-4, 7, 15 and 16.
Claim(s) rejected: 1, 5, 6, 8-14 and 17-23.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.



Edward M. Johnson
Primary Examiner
Art Unit: 1754

Continuation of 3. NOTE: The proposed amendment would change the claimed amine oxide formula specified in claims 7 and 16, and would narrow claim 23 to specify only a liquid stream, either of which would be a new issue requiring further consideration and/or search; and the former of which, along with the amendment to the specification, also raises the issue of new matter.

Continuation of 11. does NOT place the application in condition for allowance because: It is argued that the Examiner has rejected claims... ("Pounds"). This is not persuasive because Applicant appears to admit that monoethanolamine, which is an amine oxide as claimed, is disclosed.

It is argued that Pounds further discloses the use... formation of gels. This is not persuasive because Applicant appears to admit that alkanolamine is disclosed.

It is argued that lastly, it is noted that the Examiner has provided no basis... over Pounds. This is not persuasive because ethanolamine is an amine oxide, since oxygen atoms and amine groups are both present. Warrender specifically discloses morpholine (Table 2).

It is argued that in summary, since Pounds does not disclose... should not be maintained. This is not persuasive because Applicant does not claim a "product" which does not "react", as Applicant appears to suggest. Rather, claims a process with open language "comprises", which does not exclude further process steps that would create a "reaction product". It is noted that the features upon which applicant relies (i.e., a "product" which does not undergo "reaction") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

It is argued that Warrender discloses the use of reaction products... support the rejection. This is not persuasive because Applicant appears to admit that the claimed amines are disclosed and also because a recitation of the intended use (scavenging sulfides and mercaptans) of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

It is argued that none of Claims... disclosed in Oakes. This is not persuasive because Applicant appears to admit that alkanolamines are disclosed.

It is argued that further, Oakes does not disclose the invention... Claims 21-23. This is not persuasive because Applicant appears to admit that alkanolamines are disclosed.